IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES
(Attorney Docket № 14282US02)

In the Application of:

Jeyhan Karaoguz, et al.

Serial № 10/675,654

Filed: September 30, 2003

For: MIGRATION OF STORED MEDIA THROUGH A MEDIA EXCHANGE NETWORK

Examiner: Scott B. Christensen

Group Art Unit: 2444

Confirmation № 5801

Electronically filed on June 6, 2010

REPLY BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This a Reply Brief in response to the Examiner's Answer. The Appellant respectfully requests that the Board of Patent Appeals and Interferences ("Board") reverse the final rejection of claims 1-42 of the present application. This Reply Brief is timely filed within the period for reply that ends on June 6, 2010.

REMARKS

The Appellant will now address some of the issues raised by the Examiner's Answer

I. REJECTION OF THE INDEPENDENT CLAIMS

The Appellant maintains that independent claims 1, 11, 21 and 32 are patentable because the proposed combination of that Gnutella and Gregerson does not disclose or suggest at least the limitation of "automatically and without user intervention, initiating detection and detecting whether one or more of new media, data and/or service becomes newly available within the distributed network," as required by these claims. The Examiner concedes that this limitation is not taught by Gnutella and instead relies on Gregerson's "persistent query" as allegedly teaching this limitation.

> Gnutella does not disclose expressly initiating detecting without user intervention whether the one or more of new media, data, and/or service becomes newly available.
>
> However, persistent query's, such as that disclosed in Gregerson, are very well known in the art. In Gregerson, a "Persistent Find Query" is utilized to detect the availability of a resource as soon as it is available in the network (Gregerson: Column 12, lines 29-41). For a persistent query, a user initiates the initial query. If the item being searched for is not found, the system automatically, and without user intervention, searches for the item again after some interval or in a continuous fashion. Thus, any new items would be discovered when the search executes after the new item appears in the system.

(Examiner's Answer, p. 4.) However, as the Appellant has previously explained, Gregerson's "persistent query" cannot meet this limitation because it is initiated by the user. In fact, the Examiner concedes that for a persistent query, "a user initiates the initial query." (*See* Final O.A., p. 7; *see also* Examiner's Answer, p. 4).

The Examiner now attempts to sidestep this issue by proposing a claim construction which essentially reads the "automatically and without user intervention" requirement out of the claims.

> Before directly addressing Appellant's arguments, the scope of the claim should be determined. There are two parts of the step, first "initiating detection and detecting whether one or more of new media, data and/or service becomes newly available within the distributed network." The second portion is that this functionality is performed "automatically and without user intervention." The first portion is interpreted to be any process by which newly available media, data and/or service is detected. For instance, in Gnutella, a query is utilized to detect files that are available in a peer-to-peer network. As for detecting a "newly available" media file, as contended in the Final Rejection presented on 8/19/2008, this may be performed by a user manually performing repeated searches. Thus, if an initial search does not yield the desired result, the user may, at a later time, attempt the same search again, and find if the media has become available since the last search, and is thus "newly available."
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> * * *
>
> [T]he second part [of the step is] "automatically and without user intervention." **This portion is interpreted as being that the individual detection step, which is only performed once according to claim 1, is initiated automatically and without a user intervening in the initiating the individual detection step. Thus, the instant claim only requires one step of detection, and does not disclose details of how the detection is initiated, but rather how the detection is not initiated**.
>
> **Thus, as the claim must be given the broadest reasonable interpretation from the perspective of a person of ordinary skill in the art, it is clear that the step, as a whole, must be interpreted as only the single detection step, and not cover each and every detection that may be performed before the detection**. Thus, the concept of a "persistent query" is within the scope of the claim, as a persistent query, at least for one detection, initiates the detection automatically and without user intervention. A persistent query is a technique where after the query is initially created, it repeats a search a number of times at certain intervals.

(Examiner's Answer, pp. 13-14.)[1]

The Appellant acknowledges that, during patent examination, the claims are to "be given their broadest reasonable interpretation consistent with the specification." *See* MPEP 2111. However, this protocol for interpreting claims during prosecution is not without limits.

> **The protocol** of giving claims their broadest reasonable interpretation during examination **does not include giving claims a legally incorrect interpretation**. This protocol is solely an examination expedient, not a rule of claim construction. Its purpose is to facilitate exploring the metes and bounds to which the applicant may be entitled, and thus to aid in sharpening and clarifying the claims during the application stage, when claims are readily changed.

In re Skvorecz, 580 F.3d 1262, 1267 (Fed. Cir. 2009) (Reversing anticipation rejection where Board's claim construction was legally incorrect.) Rather, the Patent Office must interpret the claims "in light of the specification as it would be interpreted by one of ordinary skill in the art."

> The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004). Indeed, the rules of the PTO require that application claims must "conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description." 37 CFR 1.75(d)(1).

Phillips v. AWH Corp., 415 F.3d 1303, 1316 (Fed. Cir. 2005). This point is illustrated by the Board's recent decision in *Ex parte Technofirst S.A.* (Appeal No. 2009-010931, Reexamination No. 90/007,841, Board of Patent Appeals and Interferences, March 5,

[1] Emphasis added except where noted otherwise.

2010.)[2] In that decision, the Board reversed the examiner's claim rejections because the examiner's construction of certain claim terms was not consistent with the specification. In so doing, the Board stated the following:

> [T]the Examiner is correct that Appellant has not specifically defined that term therein. However, while giving claim terms their broadest reasonable interpretation is correct and proper, such interpretations need to be made in view of the specification. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005). With such a standard, we do not find the Examiner's alternate interpretations to be consistent with the instant Specification ... We can find no support in the Specification for such an interpretation of 'complex polynomial function.'"

(*See Ex parte Technofirst*, p. 10.)

Likewise, in the present instance the Examiner's interpretation of "automatically and without user intervention, initiating detection and detecting whether one or more of new media, data and/or service becomes newly available within the distributed network," is not reasonable "in light of the specification as it would be interpreted by one of ordinary skill in the art." The specification of the present application includes the following non-limiting example of "automatically and without user intervention."

> **Media, data, and services may be migrated through a media exchange network, according to the method 200, in a fully automatic manner with no user intervention**, or in a semi-automatic manner with some user intervention. **For example, the MPS 101 and media peripheral 109 may be configured such that, whenever new media appears in media peripheral 109 and media peripheral 109 is in range of the MPS 101, the new media may be automatically downloaded to the MPS 101 in a fully automatic manner via a wireless link 119, for example. Accordingly, no user intervention may be required.** The downloaded media could show up in the media view of the MPS 101 or may just be stored in the local storage area 114 within the MPS 101. An indication may be provided to the user, the next time the user views the TV screen or monitor of his MPS, that new media has been downloaded to the MPS 101. As an alternative, new media may be downloaded from the media peripheral 109 to the MPS 101

[2] The *Technofirst* decision appears to be unpublished.

> periodically such as, for example, once a week. In this regard, a schedule may be setup to control the periodicity of downloads.

(Application, p. 13, ¶ 0045.) Accordingly, based on this non-limiting example, one of ordinary skill in the art would understand "automatically and without user intervention" to include, for example, the situation where person carrying a PDA, e.g., a media peripheral 109, comes into range of a wireless link of a media processing system ("MPS") 109 and the MPS "automatically and without user intervention, [initiates] detection and [detects] whether one or more of new media, data and/or service becomes newly available within the distributed network[, e.g., on the PDA]." By contrast, the "persistent query" of Gregerson does not occur "automatically and without user intervention" because a user must set up the initially query.

In sum, the Examiner's interpretation of "automatically and without user intervention" is simply not how this term would be interpreted by one of skill in the art "in light of the specification." The Examiner has offered absolutely no evidence to support his proposed construction of this term.

Accordingly, for at least the reasons set forth above and in the Appeal Brief, the Appellant requests that the rejection of independent claims 1, 11, 21 and 32 be reversed.

II. OFFICIAL NOTICE REGARDING CLAIMS 8, 18, 28 AND 39

Claim 8 depends from claim 1 and further requires "scheduling said migration of said newly available one or more of new media, data and/or service to one or both of said first media processing system and/or a second media processing system within the distributed media network." The Examiner admits that the proposed combination of Gnutella and Gregerson fail to disclose or suggest this limitation, but states "Official

Notice (*See* MPEP §2144.03) is taken that this functionality is very well known in the art." (*See* Final O.A., p. 11.) In responding to this rejection, the Appellant sets forth why Official Notice without any supporting documentary evidence is improper in this instance. (*See* Appeal, pp. 13-16 and 18.) The Examiner's Answer continues to make this allegation (*see* Examiner's Answer, p. 8) and further states as follows:

> With respect to claim 8, as detailed in the rejection of claim 8, there is no requirement as to what constitutes scheduling. A download queue would constitute scheduling files. Further, simply downloading a file would be scheduling the file for download, as the file is scheduled to be immediately downloaded. Thus, the download dialog box, as provided with regard to Issue 2, shows that it was well known to select to download a file, and thus schedule a file to be immediately downloaded. Appellant has failed to provide details of how the file is scheduled to be migrated or when the file is to be migrated. Thus, as Internet Explorer allowed a file to be scheduled to be immediately downloaded, it is clear that the invention would have been well known in as much detail as required by claim 8.

(Examiner's Answer, p. 21.) The Examiner apparently alleges that manually downloading a file through Internet Explorer constitutes "scheduling" within the scope of claim 8. Once again, the Examiner has adopted an unreasonable interpretation that is at odds with the ordinary meaning of the claim language and the specification of the present application. The Examiner offers absolutely no credible support for construing "scheduling" to cover an instance where a user chooses to immediately download a file in the manner set forth above.

Accordingly, for at least the reasons set forth above in the Appeal Brief, the Appellant requests that the rejection of claim 8 be reversed. Claims 18, 28 and 39 recite similar limitations and are therefore allowable for these same reasons.

III. CONCLUSION

For at least the foregoing reasons, the Appellant submits that claims 1-42 are in condition for allowance. Reversal of the Examiner's rejection and issuance of a patent on the application are therefore requested.

The Commissioner is hereby authorized to charge any additional fees to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Respectfully submitted,

Date: June 6, 2010

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